

c<sup>1</sup> (d) disposing an electrolyte between said positive electrode having said solid organic conductive material and said negative electrode, wherein said electrolyte comprises a liquid electrolyte.

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**SEE APPENDIX FOR CHANGES MADE TO CLAIM 21**

Please add the following new claims:

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c<sup>2</sup> --33. A manufacturing method of electrolytic capacitor of claim 21, further comprising the step of disposing a separator between said positive electrode and said negative electrode.

34. A manufacturing method of electrolytic capacitor of claim 21, wherein said disposing step (d) comprises impregnating said electrolyte between said positive electrode and said negative electrode.--

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**REMARKS**

**I. INTRODUCTION**

In order to expedite prosecution, Applicants' representative initiated a telephone interview with Examiner Nguyen. Applicants and Applicants' representative would like to thank Examiner Nguyen for her courtesy in conducting the interview and for her assistance in resolving issues. During the interview, Examiner Nguyen tentatively agreed

to consider the enclosed amendment to the sole independent claim 21, which is submitted to place the application in clear and immediate condition for allowance for reasons already made of record in Applicant's amendment dated March 12, 2003. It was further agreed that if for whatever reason the Examiner does not allow the application in response to this amendment, the Examiner would contact the undersigned attorney to help expedite prosecution. The Examiner's efforts in this matter are greatly appreciated.

In addition to placing the application in clear and immediate condition for allowance, it is respectfully submitted that the enclosed amendment be entered as a matter of right because the finality of the outstanding Office Action is submitted to be premature for the reasons discussed in section II below.

**II. CLAIMS 21-23, 25-30 AND 32 ARE NOT ANTICIPATED BY, NOR  
RENDERED OBVIOUS OVER, KOBAYASHI ET AL.**

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Claims 21-23, 25-30 and 32 stand rejected under 35 U.S.C. § 102 as being anticipated by Kobayashi et al., and claims 25-30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kobayashi et al. These rejections are respectfully traversed for the following reasons.

None of the cited prior art, alone or in combination, disclose or suggest the combination of a solid organic conductive material and liquid electrolyte in the arrangement recited in claim 21. As previously noted, page 6, lines 2-10 of Applicants' specification describes one of the benefits/advantages of the combination of the solid organic conductive material and liquid electrolyte (which can provide a repair capability of the dielectric oxide film) as the ability to provide an electrolytic capacitor with

extremely low inter-polar resistance, low leak current and high dielectric strength (high withstand/spark voltage).

Another benefit/advantage of the combination of a liquid electrolyte and solid organic conductive material as recited in claim 21 is the ability for the pressure elevation inside the capacitor to be suppressed and for defective soldering to be improved (*see, e.g.*, page 13, lines 11-19 of Applicants' specification). Some additional advantages and benefits are further discussed throughout Applicants' specification. For example, the Examiner is directed to pages 36-43 of Applicants' specification corresponding to the exemplary embodiments of the present invention in comparison to comparative examples for evidence of the benefits/advantages of the present invention over the prior art (note for example comparative example 2 on page 33 without a liquid electrolyte, which has an extremely large leak current relative to exemplary Embodiment 1 of the present invention with a liquid electrolyte; *see* Table 1 on page 36 of Applicants' specification).

In contrast, the entirely solid electrolytic capacitor of Kobayashi et al. does not have enough low leak current and high dielectric strength because it can not repair the oxide film effectively due to the entirely solid structure thereof (no liquid electrolyte). As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Kobayashi et al. does not anticipate claim 21, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 25-30 and 32 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 21 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is submitted that claims 21-30 and 32 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 21-30 and 32 under 35 U.S.C. § 102/103 be withdrawn.

### **III. REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION**

It is respectfully submitted that the finality of the outstanding Office Action is premature because the Examiner set forth a new ground of rejection that was NOT necessitated by amendment. As is well known, simply because an amendment was made to the claims does not automatically allow an Examiner to make a new ground of rejection final. Rather, the amendment must have necessitated the new ground of

rejection. In the instant case, it is respectfully submitted that the amendment to claim 21 did not necessitate the new ground of rejection against claim 21 nor the new ground of rejection against claim 24.

**A. Claim 21**

In the Office Action dated December 12, 2002, the Examiner rejected claim 21 under 35 U.S.C. § 103 as being unpatentable over Kawano et al. in view of Kobayashi et al.. In the Amendment filed on March 12, 2003, Applicants amended claim 21 only by changing "electrode" to --electrolyte-- in line 6. However, this amendment was made solely to correct an inadvertent translation error so as to overcome the rejection of claim 21 under 35 U.S.C. § 112, first paragraph and NOT for overcoming the rejection over prior art.

It is respectfully submitted that the record evidences that this amendment did not necessitate the new ground of rejection. For example, in the Office Action dated December 12, 2002, the Examiner alleged that **Kawano et al.**, as the primary reference of the proposed combination under § 103, disclosed an "electrolyte." This is evidenced by the Examiner's rejection of claim 30, in which the Examiner stated that "Kawano also discloses wherein said solid organic conductive material is in a state swollen *in an electrolyte*" (see page 4, fifth paragraph of the Office Action dated December 12, 2002).

Accordingly, the Examiner already interpreted ***Kawano et al.*** as allegedly disclosing an "electrolyte." It is therefore respectfully submitted that the change in the ground of rejection was not necessitated by the amendment which changed "electrode" to --electrolyte--. That is, notwithstanding the amendment to overcome the § 112 rejection, the Examiner's ground of rejection of claim 21 under § 103 over Kawano et al. in view of Kobayashi et al. in the December 12 Office Action already took the position that the

proposed combination, without the need for further modification (i.e., Kawano et al. as the primary reference), disclosed an "electrolyte" so that the amendment did NOT necessitate the new ground of rejection. Moreover, it is respectfully submitted that the Examiner's rejection of dependent claim 30 under 35 U.S.C. § 112, second paragraph (lack of antecedent basis for "electrolyte") further evidences that the Examiner interpreted claim 21 as defining an "electrolyte" for examination purposes.

Based on all the foregoing, it is respectfully submitted that the Examiner's position with respect to Kawano et al. in the Office Action dated December 12, 2002 was that Kawano et al. disclosed all the features of claim 21, including an "electrolyte", except for "forming a solid organic conductive material on the surface of said positive electrode." Accordingly, regardless if claim 21 recited "electrode" or "electrolyte" at line 6 thereof, the Examiner's ground of rejection would have been the same according to the Office Action dated December 12, 2002.

The Examiner relied on Kobayashi et al. to modify Kawano et al. only for allegedly disclosing forming the solid organic conductive material on the surface of the positive electrode (i.e., the Examiner did not rely on Kobayashi et al. for disclosing an "electrolyte"), which proposed modification was traversed in the Amendment filed March 12, 2003. It is respectfully submitted that the change in the ground of rejection was instead necessitated by Applicants' substantive arguments on pages 5-10 of the Amendment filed on March 12, 2003 against the proposed combination, rather than the amendment to claim 21, rendering the finality of the outstanding Office Action premature.

Moreover, in view of the Examiner's rejection of claim 21 under 35 U.S.C. § 112, first paragraph, the Examiner's related rejection of claim 30 under 35 U.S.C. § 112, second

paragraph, and Applicants' specification, the amendment to claim 21 of replacing "electrode" to --electrolyte-- should have been reasonably expected by the Examiner so as to render claim 21 consistent with the specification and claim 30 in correcting the inadvertent translation error (*see* MPEP § 706.07(a); which mandates that a foreseeable amendment for overcoming § 112 rejection can NOT be basis for making a new ground of rejection final).

**B. Claim 24**

Although the amendment to claim 21 affects the scope of claim 24, it is submitted that such scope was completely unrelated to the new ground of rejection made by the Examiner. In the Office Action dated December 12, 2002, the Examiner rejected claim 24 under 35 U.S.C. § 103 as being unpatentable over Kawano et al. in view of Kobayashi et al. and Inoue et al.. Importantly, the Examiner specifically relied on Inoue et al. only for the particular feature recited in claim 24. In the Amendment filed on March 12, 2003, Applicants removed Inoue et al. as prior art against the present application by perfecting Applicants' claim to foreign priority (a reasonably expected action as noted in MPEP § 706.07(a), which precludes a new ground of rejection from being made final) without any amendment to claim 24.

In the outstanding Office Action, the Examiner now relies on newly cited Yoshimura et al. for allegedly disclosing the feature recited in claim 24. It is submitted that the amendment to claim 21 did not necessitate the new ground of rejection. For example, in both rejections, the Examiner admits that Kawano et al. in view of Kobayashi et al. and Kobayashi et al. by itself, respectively, do not disclose or suggest the feature of claim 24. Accordingly, had Inoue et al. not been removed as prior art against the present application, the Examiner would have rejected claim 24 under 35 U.S.C. § 103 over

Kobayashi et al. in view of Inoue et al. according to the Examiner's position in the Office Action dated December 12, 2002. As such, it is submitted that the use of newly cited Yoshimura et al. was not necessitated by amendment but rather was necessitated by the removal of Inoue et al. as prior art (which is not a proper basis to make a new ground of rejection final as noted in MPEP § 706.07(a)). In view of the foregoing, it is respectfully submitted that the new ground of rejection against claim 24 was necessitated by the removal of Inoue et al. as prior art against the present application and NOT based on the amendment to claim 21, which amendment did not affect the feature of claim 24 relative to the previous rejection set forth in the Office Action dated December 12, 2002.

Based on all the foregoing, it is respectfully requested that the finality of the outstanding Office Action be withdrawn and for the enclosed Amendment be entered as a response to a non-final Office Action so as to warrant entry as a matter of right, with full consideration and response from the Examiner.

#### **IV. CONCLUSION**

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this



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paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted, ✓

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**APPENDIX**

21. (Twice Amended) A manufacturing method of electrolytic capacitor comprising the steps of:

- (a) fabricating a positive electrode,
- (b) fabricating a negative electrode,
- (c) forming a solid organic conductive material on the surface of said positive electrode, and
- (d) disposing an electrolyte between said positive electrode having said solid organic conductive material and said negative electrode, wherein said electrolyte comprises a liquid electrolyte.